

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; SAMSUNG ELECTRONICS
AMERICA, INC.; and SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
Petitioner,

v.

IMBERATEK LLC,
Patent Owner.

IPR2022-01597 (Patent 8,368,201 B2)
IPR2023-00044 (Patent 8,222,723 B2)
IPR2023-00055 (Patent 9,107,324 B2)
IPR2023-00069 (Patent 7,609,527 B2)
IPR2023-00323 (Patent 7,989,944 B2)

Before DONNA M. PRAISS, JON B. TORNQUIST, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

IPR2022-01597 (Patent 8,368,201 B2)
IPR2023-00044 (Patent 8,222,723 B2)
IPR2023-00055 (Patent 9,107,324 B2)
IPR2023-00069 (Patent 7,609,527 B2)
IPR2023-00323 (Patent 7,989,944 B2)

With our authorization, Petitioner, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Austin Semiconductor, LLC, and Patent Owner, ImberaTek LLC, filed a Joint Motion to Dismiss Inter Partes Review Before Institution in each of the above-captioned cases. Paper 8 (“Joint Motions”).¹ In their Joint Motions, the parties contend that dismissal is appropriate as the *inter partes* reviews (“IPRs”) are in their early stages and the parties “have settled all disputes” related to the involved patents. *Id.* at 1–2.

With their Joint Motions, the parties filed (1) a copy of a Settlement and Patent License Agreement that the parties represent “resolves the disputes in the above-captioned *inter partes*” reviews, (2) a Confirmatory Letter from Patent Owner to Petitioner acknowledging and confirming certain facts and rights related to the Settlement and Patent License Agreement, and (3) a Joint Request to treat the settlement documents as business confidential information, to be kept separate from the files of the above-captioned patents. Ex. 1022 (“Settlement and Patent License Agreement”); Ex. 1023 (“Confirmatory Letter”); Paper 9 (“Joint Request”).

“There are strong policy reasons to favor settlement between the parties to a proceeding,” and “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal

¹ We cite to papers and exhibits filed in IPR2022-01597. Similar papers and exhibits were filed in each of the above-captioned cases.

IPR2022-01597 (Patent 8,368,201 B2)
IPR2023-00044 (Patent 8,222,723 B2)
IPR2023-00055 (Patent 9,107,324 B2)
IPR2023-00069 (Patent 7,609,527 B2)
IPR2023-00323 (Patent 7,989,944 B2)

Board Consolidated Trial Practice Guide November 2019, at 86 (citing 35 U.S.C. §§ 317(a), 327). The above-captioned IPRs are at an early stage, with the Board not yet reaching the merits of the petitions or issuing institution decisions. Thus, we find it is appropriate to dismiss the petitions and terminate the proceedings in each of the above-captioned IPRs.

We also find it appropriate to treat the settlement documents as business confidential information, to be kept separate from the files of the involved patents.

Accordingly, it is

ORDERED that the Joint Motion to Dismiss Inter Partes Review Before Institution in each of the above-captioned cases is *granted*;

FURTHER ORDERED that the parties' Joint Request that the settlement documents (Exs. 1022, 1023) be treated as business confidential information and kept separate from the files of the involved patents is *granted*; and

FUTHER ORDERED that the proceedings in the above-captioned IPRs are *terminated*.

IPR2022-01597 (Patent 8,368,201 B2)
IPR2023-00044 (Patent 8,222,723 B2)
IPR2023-00055 (Patent 9,107,324 B2)
IPR2023-00069 (Patent 7,609,527 B2)
IPR2023-00323 (Patent 7,989,944 B2)

FOR PETITIONER:

John Kappos
Benjamin Haber
William M. Fink
Jeff Baxter
O'MELVENY & MYERS LLP
jkappos@omm.com
bhaber@omm.com
tfink@omm.com
jbaxter@omm.com

FOR PATENT OWNER:

Giri Pathmanaban
Inge Osman
LATHAM & WATKINS LLP
giri.pathmanaban@lw.com
inge.osman@lw.com